

REMARKS

I. Status

Claims 1-17 are pending in the application. Claims 15-17 are withdrawn. The first proviso of claim 1 is currently amended as discussed in greater detail below.

At the outset, Applicants thank the Examiner for the indication that the rejection under 35 U.S.C. § 112, ¶2 raised in the previous Office Action is withdrawn. Applicants also thank the Examiner for the indication that the obviousness-type double patenting rejection raised in the previous Office Action is withdrawn.

In the present Office Action, claims 1-14 stand rejected under 35 U.S.C. § 102(b) over Kath *et al.*, WO 99/40061 ("WO '061"). Claims 1-14 also stand rejected under 35 U.S.C. § 102(b) over Brown *et al.*, WO 98/38167 ("WO '167"). Lastly, claims 1-14 stand rejected under 35 U.S.C. § 103(a) over WO '167. Applicants respectfully traverse the foregoing rejections.

II. Miscellaneous

Applicants kindly request again that the Examiner initial the Supplemental Information Disclosure statement filed February 20, 2004 and send a copy of it to Applicants with the next communication.

III. Claims 1-14 Are Novel Over WO '061 and WO '167

Claims 1-14 stand rejected under § 102(b) over WO '061. Claims 1-14 additionally stand rejected under § 102(b) over WO '167. Applicants respectfully traverse each rejection.

Present claim 1 is novel over WO '061 and WO '167 at least because each document does not disclose each and every element of present claim 1. The first proviso of claim 1 as amended states that if L is a bond, R⁷ may not be hydrogen. Claim 1 is novel over WO '061 and WO '167 at least because the compounds disclosed by both WO '061 and WO '167 are within the scope of the first proviso. As detailed in Applicants' Amendment and Response filed February 18, 2005, which is incorporated here by reference, to arrive at the general formulas of WO '061 and WO '167 both having an -OH group at the gamma position relative to the right side carbonyl group, L would be a bond and R⁷ would be hydrogen in the context of present claim 1. But, the first proviso of claim 1 states that when L is a bond, R⁷ may not be hydrogen. Therefore, the compounds disclosed by WO '061 and WO '167 do not anticipate claim 1.

While not expressly mentioned by the Examiner in the context of present claim 1 but rather in the context of previously presented claim 1, it is worth mentioning that Applicants respectfully believe the Examiner's interpretation of the proviso leading to the present rejections is misplaced. The Examiner appears to believe that the presence of the term "may" in the proviso renders it conditional. Specifically, the Examiner appears to believe that the presence of the term "may" in proviso means that R⁷ may or may not be hydrogen. The Examiner is correct in believing that R⁷ may or may not be hydrogen. Where the Examiner's analysis runs astray from general convention, however, is in believing that R⁷ may or may not be hydrogen due to the presence of the term "may" in the proviso. A proviso by nature is conditional. Thus, a proviso need not contain the word "may" to be conditional. For example, the fictitious proviso, "...with the proviso that when A is black, B is not white" is certainly conditional and does not contain the term "may". To say that the term "may" causes the proviso to be conditional seems to undermine the very nature of a proviso.

As such, the term “may” does not necessarily render a proviso conditional. In the context of current claim 1 then, the presence of the term “may” in the proviso does not necessarily make it conditional, as suggested by the Examiner. The proviso as amended (like the previous version of the proviso) is certainly clear. Simply stated, when L is a bond, R⁷ may not be hydrogen. Thus, when L is not a bond, the proviso does not apply and R⁷ can be hydrogen in addition to certain other defined groups. The proviso does not indicate that when L is a bond, R⁷ *may* be hydrogen. (emphasis added). Such an interpretation is the complete antithesis of the plain meaning of the proviso as originally and currently presented.

In addition, the Examiner has not shown with support how his interpretation of the term “may” to include “may not” is correct, which it is not. Therefore, Applicants respectfully request reconsideration of the present rejection and its removal at this time.

IV. Claims 1-14 and 8-11 Are Not Obvious Over WO '167

Claims 1-14 stand rejected under § 103(a) over WO '167. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the cited document(s) must teach or suggest all of the claim elements. Second, there must be some suggestion or motivation, either in the documents themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the documents or to combine the documents teachings. Third, there must be a reasonable expectation of success. Here, WO '167 does not satisfy any of the three foregoing requirements, which are discussed in turn.

Applicants respectfully traverse the rejection because WO '167 does not teach or suggest each and every element of claim 1. As discussed in detail above, WO '167 teaches an -OH group at the gamma position relative to the right side carbonyl group corresponding in position to the -O-L-R⁷ moiety of present claim 1. The first proviso, however, states that when L is a bond, R⁷ may not be hydrogen. As such, WO '167 does not teach or suggest compounds within the scope present claim 1.

In addition, WO '167 does not suggest a modification to arrive at the genus defined by claim 1. The Examiner also has not indicated with support the source of motivation for the required modification to the extent it exists, which it does not. The Examiner instead states at page 5 of the Office Action, "The instant claimed quinoxaline derivatives and their compositions would have been suggested to one of ordinary skill because one of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention since Brown et al. specifically teach quinoxaline derivatives." Besides being somewhat circular in nature, the Examiner's assertion appears to be misplaced since the Examiner has not indicated with support which of the variables in the WO '167 general formula would be desirable to modify, if any. Instead, the Examiner merely asserts that because WO '167 teaches quinoxaline derivatives, one of ordinary skill would be motivated to modify the compounds it teaches to arrive at the presently claimed compounds. Certainly, such a general teaching would not lead those of skill in the art to arrive at the presently claimed compounds. Without a more specific teaching indicated by the Examiner, Applicants believe the Examiner has not satisfied his burden of establishing the requisite suggestion to modify. Absent motivation, there is no reasonable expectation of success.

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As such, claim 1 is not obvious over WO '167. Claims 2-13 are not obvious over WO '167 at least by virtue of their direct or indirect dependency from novel claim 1. Claim 14 is not obvious over WO '167 at least by virtue of it defining an amount of a compound according to novel claim 1. Therefore, removal of the present rejection is respectfully requested at this time.


V. Conclusion

Having addressed all outstanding issues, Applicants kindly request removal of all rejections and allowance of all pending claims at this time. To the extent the Examiner believes that it would facilitate allowance of this case, the Examiner is urged to call the undersigned at the number below.

Applicants believe that no fee is associated with the filing of this paper. However, to the extent a fee is due, the Commissioner is hereby authorized by this paper to charge any required fees or credit any overpayment to Deposit Account 16-1445.

Respectfully submitted,

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